



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/504,783	02/15/2000	Edmund Colby Munger	00479.85672	8308

7590 03/13/2002

Banner & Witcoff, Ltd
1001 G Street, NW
Washington, DC 20001-4597

EXAMINER

LIM, KRISNA

ART UNIT	PAPER NUMBER
----------	--------------

2153

DATE MAILED: 03/13/2002

#8

Please find below and/or attached an Office communication concerning this application or proceeding.

H G

Office Action Summary	Application No. 09/504,783	Applicant(s) MUNGER ET AL.	
	Examiner Krishna Lim	Art Unit 2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-39 and 67-81 is/are pending in the application.
- 4a) Of the above claim(s) 72-81 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-37 and 67-69 is/are rejected.
- 7) ☒ Claim(s) 38,39,70 and 71 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2, 3</u> . | 6) <input type="checkbox"/> Other: _____ |

1. Applicant's election without traverse of Group II (claims 28-39 and 67-71) in Paper No. 5 (filed 1/28/02) is acknowledged.
2. Claims 28-39 and 67-71 are pending for examination, and claims 72-81 are newly added for examination.
3. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

II. Claims 28-39 and 67-71, drawn to a system for transparently creating a virtual private network (VPN) between a client computer and a target computer, comprising: a) generating from the client computer a DNS request ..., b) determining whether the DNS ..., c) determining that the DNS ..., classified in Class 709, subclass 249.

IV. Claims 72-81, drawn to a method for establishing an encrypted channel between a client and a secure host, comprising the step of automatically creating the encrypted channel upon intercepting a DNS request for a domain name comprising a predetermined domain name extension, classified in Class 713, subclass 201.

4. Inventions II and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are

shown to be separately usable. In the instant case, invention II has separate utility such as a method of registering a node that does not support Mobile IP with a Home Agent that support Mobile IP lacks the step of automatically creating the encrypted channel upon intercepting a DNS request for a domain name comprising a predetermined domain name extension.

5. These inventions are distinct for the reasons given above, and the search required for each Group is different and not co-extensive for examination purpose.

6. For example, the searches for the four inventions would not be co-extensive because these groups would require different searches on PTO's classification class and subclass as following:

1) The Group II search (claims 28-39 and 67-71) would require use of search class 709, subclass 249 (which would not required for the group IV).

2) The Group IV search (claims 72-81) would require use of search class 713, subclass 201 (which would not required for the group II).

7. Newly submitted claims 72-81 are directed to an invention that is independent or distinct from the invention originally claimed as mentioned in paragraphs 3-6 above.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for

prosecution on the merits. Accordingly, claims 72-81 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims are rejected under 35 U.S.C. § 103(a) as being unpatentable over Boden et al. [U.S. Patent No. 6,330,562 B1] in view Risley et al. [U.S. Patent No. 6,332,158 B1].

10. Boden et al. disclosed (e.g., see Figs. 3A, 3B, 3C and 3D) the invention substantially as claimed. Taking claim 37 as an exemplary claim, the reference disclosed a system for dynamically establishing a virtual private network (VPN) (e.g., see col. 3, lines 14-20) with different security policies and other attributes between a client computer and a target computer, and a system for supporting with dynamically-assigned IP addresses that wished to establish a VPN connection with the locally system and means for maintaining secure connections at the IP level with other VPN

nodes (e.g., see the last 2 lines of the abstract) and means for enabling handling of remote initiating hosts with dynamically assigned IP address.

11. Boden et al., however, did not explicitly detail a DNS proxy server that receives a request from a client computer to look up an IP address for a domain name either returned the IP address for the request domain name or returned an error message. Such feature was clearly taught by Risley et al. (e.g., see an abstract, the teaching of query www.bessemerventures.com and the return answer of 180.201.15.250 of Fig. 1A, the teaching Fig. 1B, the detail teaching of Fig. 4, col. 1 (lines 48-50, 55-61), col. 2, col. 5 (lines 45-50)).

Establishing a secure connection between computers with the use of VPN would have been a desired feature in the art as suggested by the Boden et al. (e.g., see col. 1, lines 41-55)). In addition, the system that made it easier to remember, access, and convey the location information in order to access information would have been also a desired feature in the art as suggested by Risley et al. (e.g, see col. 1, lines 46-52). Thus, it would have been obvious to one of ordinary skill in the art to combine the teaching of these two references in order to have an easier to use and secure network connection because the teaching of these two references are complemented each other for easier to use and for securing network connection in a computer network.

12. Claims 38-39 and 70-71 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. Claims 28-36 and 67-69 are similar in scope as of claims 37, and therefore claims 28-36 and 67-69 are rejected for the same reasons set forth above for claim 37.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The references are cited in the Form PTO-892 for the applicant's review.

A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Krisna Lim whose telephone number is (703) 305-9672. The examiner can normally be reached on Monday-Friday from 7:00 to 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Glenton Burgess, can be reached at (703) 305-4772. The fax phone numbers for the organization where this application or proceeding is assigned is are as following:

(703) 746-7238 [After Final Communication]

or

(703) 746-7239 [Official Communication]

(703) 746-7240 [For Status inquiries, draft communication]

and/or

(703) 306-5631, (703) 306-5632 or (703) 306-5633 for [Customer Service Numbers]

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

All Internet e-mail communication will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirement of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Office Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

kl

March 10, 2002



KRISHNA LIM
PRIMARY EXAMINER